

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 1, 5, 19, 24, 26 and 27 are amended, claim 23 has been cancelled and claims 28-31 have been added. Claims 1-22 and 24-31 are now pending in view of the aforementioned cancellations and new claims.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

In connection with the matters contemplated hereby, Applicant respectfully notes at the outset that the discussion herein should not be construed to constitute an exhaustive enumeration of the distinctions between the claims of the present application and the references cited by the Examiner. Instead, such distinctions are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner.

Applicant notes further that the arguments and/or amendments presented herein have been made merely to clarify the claimed invention from elements purported by the Examiner to be disclosed by the cited references. Such arguments and/or amendments should not, however, be construed as acquiescence on the part of the Applicant as to the purported teachings or prior art status of any of the cited references, nor as to any characterization of the cited references advanced by the Examiner. Accordingly, Applicant reserves the right to challenge the purported teaching and prior art status of any and all of the cited references at any appropriate time.

### **II. Objections to the Drawings**

Examiner objects to the drawings as "failing to comply with 37 CFR 1.84(p)(4) because reference character '130' has been used to designate both the optical element and optical axis." The Examiner has also objected to the drawings under 37 CFR 1.85(p)(5) stating that the

drawings fail to comply “because they do not include the following reference sign(s) mentioned in the description: 23 (optical axis; spec, page 8 line 6).”

In view of the amendments to the specification herein, Applicant respectfully submits that no changes are required to the drawings and, further, that the aforementioned objections have been overcome and should be withdrawn.

### **III. Objection to claim 23**

The Examiner has objected to claim 23, stating that “The statement ‘ . . . light that is reflected by detector . . . ’, should read ‘ . . . light that is reflected by [*a or the or said*] detector . . . ’.” In light of the cancellation of claim 23 herein, Applicant submits that the aforementioned objection has been rendered moot and should be withdrawn.

### **IV. Rejection under 35 U.S.C. § 102(e)**

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102 (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *See* Manual of Patent Examining Procedure (“M.P.E.P.”) § 2131.01.

The Examiner rejects claims 1, 5, and 23 under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application No. US 2003/0138210 A1 to Steinberg, et al. (“*Steinberg*”). Applicant disagrees with all of the claim rejections, and notes that in view of the cancellation herein of claim 23, the rejection of that claim has been rendered moot and should be withdrawn. As to claims 1 and 5, Applicants respectfully traverse the rejection of those claims for at least the reasons outlined below.

While Applicant disagrees with the contentions of the Examiner, Applicant has amended claim 1 herein to recite, among other things, “the substantially flat side of the optical element is oriented perpendicular to an optical axis associated with the optical coupler.” Support for this amendment can be found, for example, in Figures 1 and 6 of the application as filed.

In contrast with the arrangement recited in claim 1, the portion of *Steinberg* relied upon by the Examiner provides in part that “A endface 26 of the fiber array and optical fiber 20 is

nonperpendicular with respect to an optical axis 28. The endface 26 is at an angle T with respect to a plane perpendicular to the optical axis 28” (emphasis added). Further, *Steinberg* goes on to state that “A transparent, homogeneous block 29 is disposed on the endface 26. The block has an entrance face 30 and an exit face 32. The entrance face 30 is angled at the angle T.” See paragraph 0014, Figures 1-3, 5 and 7 of *Steinberg*.

As the foregoing makes clear, the invention that is the subject of amended claim 1 is substantially different from the device disclosed in the portion of *Steinberg* upon which the Examiner relies. Particularly, amended claim 1 requires that “the substantially flat side of the optical element is oriented perpendicular to an optical axis associated with the optical coupler” (emphasis added), while *Steinberg* states, as noted above, that “the endface of the fiber array and optical fiber [are] nonperpendicular with respect to an optical axis” (emphasis added).

Accordingly, Applicant submits that the Examiner has not established that *Steinberg* teaches each and every element of amended claim 1. Particularly, the Examiner has not established that *Steinberg* teaches “an optical element having a substantially flat side and a substantially convex side . . . wherein the substantially flat side of the optical element is oriented perpendicular to an optical axis associated with the optical coupler” such as is recited in amended claim 1.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of claims 1 and 5 has been overcome and should be withdrawn.

#### V. Claim Rejections under 35 U.S.C. § 103(a)

With reference to the obviousness rejections posed by the Examiner in the Office Action, Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143.

The Examiner has rejected claims 14 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over *Steinberg*. For at least the reasons outlined below, Applicant respectfully disagrees with the Examiner.

In the rejection of the claims, the Examiner concedes that “Steinberg does not teach expressly the output light being coupled to a detector where less than half of the light is reflected back to the light source or a light emitting diode (LED) source.” However, the Examiner then goes on to state that “At the time the invention was made, it would have been obvious to one of ordinary skill in the art to infer that less than half the light is reflected back in the coupler taught by Steinberg since the purpose of the invention is to reduce back reflections and since it was known in the art that a reduced back reflection system is a system that achieves less than half of the light being back reflected” (emphasis added).

While Applicant is unclear on this point, it appears that the Examiner is taking the position that: (a) the purpose of the *Steinberg* device is to reduce back reflections and, accordingly, it is obvious to infer that this reduced back reflection results in a limitation of less than half of the light being reflected back; and, (b) once the aforementioned limitation is inferred with respect to the *Steinberg* device, then it is evident that the *Steinberg* device includes all the limitations of the claimed invention.

It would thus appear that while the Examiner has apparently asserted that it would be obvious to infer a reference teaching, the Examiner has made no assertion that it would be obvious to one of skill in the art to modify the teachings of *Steinberg*, or that it would be obvious to one of skill in the art to combine the teachings of *Steinberg* with those of some other reference. More particularly, the Examiner appears to be applying some sort of “obvious to infer” standard as a basis for determining the scope of the disclosure of the *Steinberg* reference, rather than applying the obviousness standard noted above and provided for under 35 U.S.C. § 103(a). Applicant respectfully submits however that “obvious to infer” is not the appropriate standard to be applied in making a claim rejection under 35 U.S.C. §103(a).

Because the Examiner has employed an incorrect analytical approach to the rejection of claims 14 and 20-22, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to those claims. Applicant thus submits that the rejection of claims 14 and 20-22 has been overcome and should, accordingly, be withdrawn.

## **VI. Dependent claims Rewritten in Independent Format**

The Examiner has objected to claims 24-27 as being dependent on a rejected base claim, but has indicated that such claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

In connection with the foregoing, Applicant respectfully notes that an objection, by definition, concerns only the form of the claim(s) (as distinguished from the substance of the claim) with respect to which the objection has been posed. *See* M.P.E.P. §§ 706.01, 608.01(n) (emphasis added). Thus, simply rewriting a dependent claim in the manner suggested by the Examiner constitutes only a change to the format of the claim and, without more, has no effect with regard to the substance of the rewritten claim.

Because Applicant has made no change to claims 24, 26 and 27 other than to rewrite such claims in independent form to include all of the limitations of the base claim and any intervening claims, Applicant respectfully submits that no change has been made herein to the substance of such claims and, further, that such claims, as rewritten herein, are now in condition for allowance.

## **VII. New Claims 28-31**

By this paper, Applicant has added new claims 28-31. Claims 28 and 29 depend from claim 1 and claims 30 and 31 depend from claim 6. Support for these claims is found in figures 4 and 5 and lines 11-22 of page 6 and lines 1-19 of page 7. In view of the discussion herein concerning claim 1, Applicant submits that new claims 28 and 29, depending from claim 1, are in allowable condition. Because new claims 30 and 31 depend from claim 6, indicated by the Examiner to be in allowable condition, Applicant submits that new claims 30 and 31 are likewise in allowable condition.

## **VIII. Allowable Subject Matter**

Applicant acknowledges with thanks the indication of the Examiner that claims 6-13 are allowed, and Applicant also wishes to thank the Examiner for the careful review of those claims. Further, Applicant acknowledges the indication of the Examiner that claims 2-4, 15-19 and 24-

27 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims.

Applicant submits the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the Examiner that the inventions to which claims 2-4, 6-13, 15-19 and 24-27 are directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claims allowable and Applicant does not make any admission or concession concerning the Examiner's statement in the Office Action.

**Conclusion**

In view of the discussion and amendments submitted herein, the applicant respectfully submits that each of the pending claims 1-22 and 24-31 are in condition for allowance. Therefore, reconsideration of the rejection is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that can be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 26<sup>th</sup> day of May, 2005.

Respectfully submitted,



Peter F. Malen, Jr.  
Attorney for Applicant  
Registration No. 45,576  
Customer No. 022913  
Telephone No. (801) 533-9800